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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,624	08/17/2001	Robert P. Bourdelais	83020PAL	6304

7590

01/28/2004

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/28/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,624

Applicant(s)

BOURDELAIS ET AL.

Examiner

Catherine Simone

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 2-14 and 16-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 2-14 and 16-34 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

Applicant's election with traverse of species C, claim 15, in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the various species pointed out by the Examiner do not require separate searches. This is not found persuasive because the various species would require separate searches and would cause undue burden on the Examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Coleman et al. (5,327,201).

Coleman et al. discloses an article comprising an image member comprising a polymer sheet having an image adhered thereto (see col. 11, lines 60-63) permanently adhered to a functional base (see col. 12, lines 27-31) wherein the image member and the functional base

interact to create a new image utility and wherein the polymer sheet has thickness of less than 250 micrometers (see col. 11, lines 8-13).

4. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Cherian (5,337,132).

Cherian discloses an article comprising an image member comprising a polymer sheet (Figs. 2 and 3, #25) having an image adhered thereto (Figs. 2 and 3, #67; also see col. 11, lines 45-46) permanently adhered to a functional base (Figs. 2 and 3, #116; also see col. 12, lines 40-52) wherein the image member and the functional base interact to create a new image utility and wherein the polymer sheet has thickness of less than 250 micrometers (see col. 11, lines 14-19).

5. **Claims 1 and 15** are rejected under 35 U.S.C. 102(b) as being anticipated by Punton (WO 90/00760)

Punton discloses an article comprising an image member comprising a polymer sheet having an image adhered thereto (see page 6, lines 8-10) permanently adhered to a functional base (see page 4, lines 21-24 and page 5, lines 12-20) wherein the image member and the functional base interact to create a new image utility and wherein the polymer sheet has thickness of less than 250 micrometers (see page 4, lines 16-20). Regarding **claim 15**, note the functional base comprises a microembossed polymer (see page 4, lines 24-27 and page 5, lines 24-26).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman et al. (5,327,201) or Cherian (5,337,132) in view of Furuya et al. (JP 09-244180).

Both Coleman et al. and Cherian disclose an article comprising an image member comprising a polymer sheet having an image adhered thereto permanently adhered to a functional base wherein the image member and the functional base interact to create a new image utility and wherein the polymer sheet has thickness of less than 250 micrometers. However, both fail to disclose the functional base being a microembossed polymer. Furuya et al. teaches that it is old and well-known in the art to have a microembossed polymer for the purpose of providing a functional base for an article with a photographic image.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided either Coleman et al. or Cherian with a microembossed polymer base as suggested by Furuya et al. in order to produce an article with a photographic image.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0987.


Catherine Simone
Examiner
Art Unit 1772
January 22, 2004


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/23/04